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**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q59305

Yasuharu AOKI, *et al.*

Appln. No.: 09/588,344

Group Art Unit: 2143

Confirmation No.: 8131

Examiner: Phuoc H. Nguyen

Filed: June 7, 2000

For: **METHOD OF PERFORMING A PROCESS AND CLIENT SERVER SYSTEM**

**SUBMISSION OF SUBSTITUTE APPELLANT'S BRIEF ON APPEAL**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an original and two copies of Substituted Appellant's Brief on Appeal Under 37 C.F.R. § 1.192.

The Substitute Appellant's Brief on Appeal Under 37 C.F.R. § 1.192 is submitted pursuant to the November 17, 2004 Notification of Non-Compliance under 37 CFR 1.192(c) which indicates that claim 23 was not listed in the Appendix. The substitute Brief further specifically identifies the claims on appeal.

Although 37 C.F.R. § 1.192 has been replaced with 37 C.F.R. § 41.37(c), as indicated in the Rules of Practice before the Board of Patent Appeals and Interferences,<sup>1</sup> Appellant need only comply with 37 C.F.R. § 1.192. Consequently, claim 23 has been added to the Appendix.

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<sup>1</sup> <http://www.uspto.gov/web/offices/dcom/bpai/fr2004/bpaifaq.html>

...(footnote continued)

SUBMISSION OF SUBSTITUTE APPELLANT'S BRIEF ON APPEAL  
U.S. Application No. 09/588,344  
Attorney Docket No. Q59305

It is believed that no fee is required. If this is incorrect, the USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

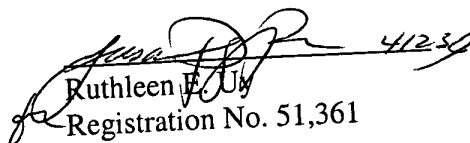
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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

  
Ruthleen E. [unclear]  
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Date: December 15, 2004

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**A6. If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of § 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with § 41.37(c)?**

No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former § 1.192 or § 41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.



## PATENT APPLICATION

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 1.192, Appellant submits the following:

#### **I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is Fuji Photo Film, Co., Ltd. of Japan. The assignment was previously submitted and was recorded on October 6, 2000 at Reel 011210, Frame 0107.

#### **II. RELATED APPEALS AND INTERFERENCES**

To the knowledge and belief of Appellant, the Assignee, and the undersigned, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

### **III. STATUS OF CLAIMS**

Claims 1-35 are pending in the application. Claims 34 and 35 were allowed. Claims 4, 9, 25-27 and 29-32 have been objected to but would be allowed if rewritten in independent form.

Claims 1-3, 5-8, 10-22, 24, 28 and 33 currently stand finally rejected under 35 U.S.C. §102(e) as being anticipated by Jebens et al. (USP 6,321,231). Claim 23 currently stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Jebens in view of Aldus Corporation, "OPI Open Prepress Interface Specification," (hereinafter "Aldus") 22 September 1993, pages 5-15.

No other ground of rejection or objection is currently pending.

The rejections of claims 1-3, 5-8, 10-22, 23-24, 28 and 33 are being appealed.

### **IV. STATUS OF AMENDMENTS**

With the filing of this Brief, all Amendments have been entered and considered by the Examiner. In response to the non-final first Office Action (Paper No. 3), Appellant filed an Amendment under 37 C.F.R. § 1.111 on September 15, 2003 containing amendments to claims 1, 6, 11, and 16 and adding claims 21-35. In response to the second final Office Action, Appellant filed a Response under 37 C.F.R. § 1.116 on March 23, 2004. A first Advisory Action (Paper No. 8), was mailed April 2, 2004, and this Appeal was undertaken.

The Appendix included with this Brief, setting forth the claims involved in the appeal, reflects all of the claim changes made in the above identified Amendment.

There are no outstanding Amendments affecting the status of the claims in this appeal.

V. SUMMARY OF THE INVENTION

Appellants' invention relates to a method of performing a data process and to a client server system. In Desktop Publishing (DTP), editing and printing operations of documents are performed using a personal computer. Original image data containing a large number of megabytes is often used in order to obtain high quality printed matter. Since a large number of megabytes is used to obtain high quality printed matter, Open Prepress Interface (OPI) has been established to help manage the editing of a large amount of data. In particular, OPI is used to create low resolution image data by thinning original image data or high resolution image data. An editing operation is performed using the low resolution image data and the low resolution image data is replaced with high resolution image data at the time of output. By editing low resolution image data instead of high resolution image data, an increase in the amount of data transmitted is avoided and deterioration of data transmission efficiency over the entire network system can be prevented. See Specification at pgs. 1 and 3.

However, with conventional OPI systems, as illustrated in Fig. 13, exclusive-use software is needed to invoke functions of the server device for each type of client device. In addition, users need to install the exclusive-use software in advance on each client device. See Specification at pg. 2.

Appellants' invention overcomes the deficiencies in the conventional art since exclusive-use software is not needed for each client device. Instead, a server device constantly monitors prescribed folders in the server device and when a command file which instructs execution of a designated process is recognized in a prescribed folder, the process instructed by the command file is performed. See Specification at pg. 4; See also Fig. 9.

## **VI. ISSUES**

1. Whether the Examiner's rejection of claims 1-3, 5-8, 10-22, 24, 28 and 33 under 35 U.S.C. § 102(e) as being anticipated by Jebens is proper.
2. Whether the Examiner's rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Jebens in view of Aldus is proper.

## **VII. GROUPING OF CLAIMS**

For the anticipation rejection of claims 1-3, 5-8, 10-22, 24, 28 and 33 in view of Jebens, the claims do not stand or fall together for purposes of this appeal.

For the obviousness rejection of claim 23 in view of Jebens and Aldus, claim 23 stands alone.

The claims should be analyzed in the following groups:

- Group 1: Claims 1, 2, 6, 7, 11, 12, 16, and 17 stand or fall together.
- Group 2: Claims 3, 5, 8, 10, 13, 14, 18, and 19 stand or fall together.
- Group 3: Claims 15 and 20 stand or fall together.
- Group 4: Claim 22 stands or falls alone.
- Group 5: Claim 24 stands or falls alone.
- Group 6: Claim 28 stands or falls alone.
- Group 7: Claim 23

## **VIII. ARGUMENTS**

Appellant respectfully requests that the members of the Board reverse the rejection of claims 1-3, 5-8, 10-22, 24, 28 and 33 under 35 U.S.C. § 102(e) as being anticipated by Jebens

since Jebens fails to disclose each and every feature of claims 1-3, 5-8, 10-22, 24, 28 and 33.

Further, Appellants respectfully request that the members of the Board reverse the rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Jebens in view of Aldus since the combination of Jebens and Aldus does not teach each and every feature of claim 23 .

Appellant acknowledges that all of the claims relate to executing data processing.

However, as set forth below, each group recites a different limitation of the data processing.

Group 1: Independent claims 1, 6, 11 and 16 and dependent claims 2, 7, 12 and 17 stand or fall together as they recite when existence of a command file which instructs execution of a designated process is recognized in the prescribed folders, the process instructed by the command file is performed.

Group 2: Dependent claims 3, 5, 8, 10, 13, 14, 18, and 19 stand or fall together as they recite that the command file commands execution of a designated process which is performed in the OPI system. The command file instructs execution of a process in a system not suggested by the remaining groups.

Group 3: Dependent claims 15 and 20 stand or fall together as they recite replacing low resolution image data with high resolution image data at a time of output. The replacement permits more efficient transfer of information which is not contemplated or suggested by the remaining groups. The authentication provides a more secure and flexible access to folder processes not contemplated or suggested by the remaining groups.

Group 4: Dependent claim 22 stands or falls alone as it recites a command file comprises authentication information comprising a request to manage prescribed folders.

Group 5: Dependent claim 24 stands or falls alone as it recites that low resolution image data comprises a file name, data location path, folder ID and format information of high resolution image data. The specific requirements interrelate high and low resolution information to allow processing to be executed in a more efficient manner not suggested by the remaining groups.

Group 6: Dependent claim 28 stands or falls alone as it recites that an OPI Daemon of the server device constantly monitors the prescribed folders of the server device. The specific requirements describe the constant monitoring of folders not suggested by the other groups.

Group 7: The separate ground of rejection of claim 23 warrants a separate grouping of the claim.

Accordingly, the claims in groups 1-7 are believed to be separately patentable because of the limitations therein, and therefore, they do not stand and fall together.

**Group 1: Argument 1: The Examiner improperly cites the same element in the prior art for teaching different structural limitations of the claims**

Claims 1 and 6 describe that when the existence of a command file which instructs execution of a designated process is recognized in the prescribed folders, the process instructed by the command file is performed. The Examiner cited col. 10, lines 18-37, col. 18, lines 55-66 and col. 19, lines 14-35 for teaching this aspect of claims 1 and 6.

The Examiner appears to be referring to the image document for teaching the claimed command file. However, based on the Examiner's rejection of claims 3 and 8, the Examiner's rejection of either 1 and 6 or 3 and 8 must fall. In particular, the Examiner cited the image document for teaching the command file of claims 1 and 6, then later cited the image document



for teaching the low resolution image data of claims 3 and 8. See Paper No. 5, paragraph 5 and paragraph 7. The same elements in the prior art cannot be duplicately cited for teaching different structure elements as recited in the claims.

**Group 1:      Argument 2: Jebens does not disclose a command file which instructs execution of a designated process**

As previously indicated, the Examiner cited the image document of Jebens for teaching a command file. An image document itself cannot execute any process. Rather, a program would have to be applied to the document. The document of Jebens contains image data and information pertaining to the image data. Col. 3, lines 3-6. A user's system contains many folders, each associated with a particular destination or sending site. After the document data is placed in a folder, the data is compressed and sent to the appropriate location. See Fig. 10A and col. 18, lines 48-56. Once the destination host has received the data, the data is decompressed, and stored in the host system. See Fig. 10B. The image data can later be edited by a user who retrieves the image data from the host system.

Based on the foregoing, it is apparent that the image data does not instruct execution of a designated process in the prescribed folder nor is a process performed based on instructions by the image data, as described in the claimed invention. Therefore, claims 1 and 6 and their dependent claims should be deemed patentable. Since claims 11 and 16 describe similar elements, claims 11 and 16 and their dependent claims should be deemed patentable for the same reasons.

**Group 2:      Jebens does not disclose a command file which commands execution of a designated process which is performed in an OPI system**

As an initial matter, because the claims of Group 2 are dependent upon the claims of Group 1, the arguments set forth for Group 1 also apply to Group 2.

Claims 3 and 8 describe that the command file commands execution of a designated process which is performed in the OPI system. The Examiner cited Figs. 1 and 4C and col. 5, lines 11-35 of Jebens for teaching this aspect of claims 3 and 8.

Fig. 1 generally illustrates that the data management and work order delivery system of Jebens. An OPI system does not appear to be disclosed in the figure. Fig. 4C is a flow chart illustrating the autolog routine. An OPI file is created at step 232. However, there is no indication of an OPI system or that a command file commands execution of a designated process in an OPI system.

The respective column and lines cited by the Examiner describes permission rights of an agency to access certain image documents and downloading images in low resolution. The mere indication of low resolution images does not equate with an OPI system. At most, Jebens teaches that an OPI file can be created from an original image file. Col. 10, lines 53-56. There is no indication of an OPI system and the execution of a designated process in the OPI system. Therefore, claims 3 and 8 should be deemed patentable. Since claims 13 and 18 describe similar elements, they should be deemed patentable for the same reasons.

**Group 3: Jebens does not disclose a server device which replaces low resolution image data with high resolution image data at a time of output**

As an initial matter, because the claims of Group 3 are dependent upon the claims of Group 2, and indirectly dependent upon the claims of Group 1, the arguments set forth for Groups 1 and 2 also apply to Group 3.

Claims 15 and 20 describe that the server device replaces the low resolution image data with the high resolution image data *at the time* of output. The Examiner cites Jebens Figs. 1 and 4C and col. 5, lines 15-35 for teaching claims 15 and 20.

In Jebens, once an agency has completed editing a document, the agency logs back onto the system and transmits the high resolution edited document to the host. The document can then be transmitted to another location for printing. Therefore, since a high resolution document is edited and transmitted, low resolution image data is not replaced with the high resolution image data at the time of output, as described in claims 15 and 20.

**Group 4:     Jebens does not disclose a command file which comprises  
authentication information comprising a request to manage  
prescribed folders**

As an initial matter, because the claim of Group 4 is dependent upon a claim of Group 1, the arguments set forth for Group 1 also apply to Group 4.

Claim 22 describes that the command file comprises authentication information comprising a request to manage the prescribed folders. As previously indicated, the command file of Jebens cited by the Examiner, is merely an image data document. Although the system requests authentication information from a user before a user can log on to the system, the image data itself does not comprise authentication information. Therefore, claim 22 should be deemed patentable.

**Group 5: Jebens does not disclose low resolution image data comprising a file name, data location path, folder ID and format information**

As an initial matter, because the claims of Group 5 are dependent upon the claim of Group 2, and indirectly dependent upon the claim of Group 1, the arguments set forth for Group 1 and 4 also apply to Group 5.

Claim 24 describes that the low resolution image data comprises a file name of the corresponding high resolution image data, a data location path of the high resolution image data, a folder ID of the prescribed folder in which the high resolution image is stored and a format information of the high resolution image data. The Examiner cites Jebens col. 2, last paragraph to col. 3, first paragraph and col. 8, 2<sup>nd</sup> paragraph for teaching claim 24.

The respective column and lines cited by the Examiner describes that a high and low resolution copy of digital images are stored in a searchable format. A user locates and downloads a low resolution copy of an image, an electronic file defining a document is received, and instructions regarding delivery of the file are received. A high resolution copy of the data is sent to another user for publication. There is no indication that the low resolution image data comprises the file name, data location path, folder ID and format information of claim 24. Therefore, claim 24 should be deemed patentable.

**Group 6: Jebens does not disclose an OPI daemon or that an OPI daemon of a server device constantly monitors prescribed folders of the server device**

As an initial matter, because the claim of Group 6 is dependent upon a claim of Group 1, the arguments set forth for Group 1 also apply to Group 6.

Claim 28 describes that the OPI daemon of the server device constantly monitors the prescribed folders of the server device. The Examiner cites col. 10, lines 18-37, col. 18, lines 55-66 and col. 19, lines 14-35 for teaching claim 28. The respective columns and lines cited by the Examiner describes the compression of documents and the transfer of image document to destination folders. There is no indication of an OPI daemon, therefore, claims 28 should be deemed patentable.

**Group 7: Claim 23 should be deemed patentable by virtue of its dependency to independent claims**

Claim 23 should be deemed patentable by virtue of its direct and indirect dependency to claims in Groups 1 and 2 for the reasons set forth with respect to Groups 1 and 2.

## **IX. CONCLUSION**

Appellants respectfully requests the members of the Board to reverse the rejection of claims 1-3, 5-8, 10-22, 23, 24, 28 and 33 and to find each of the claims allowable as defining subject matter which is not anticipated by Jebens or made obvious by the combination of Jebens and Aldus.

The present Brief on Appeal is being filed in triplicate. Unless a check is submitted herewith for the fee required under 37 C.F.R. §1.192(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

SUBSTITUTE APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192  
U.S. APPLN. NO.: 09/588,344 ATTORNEY DOCKET NO. Q59305

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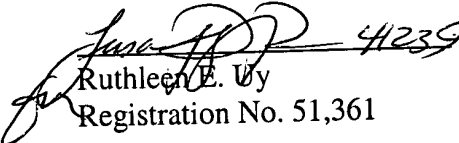
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**APPENDIX**

**CLAIMS 1-3, 5-8, 10-22, 23, 24, 28 and 33 ON APPEAL:**

1. A method of performing a process by means of a server device, the method being used in a client server system for executing a designated data processing, in which a client device and a server device are connected via a network, wherein:

the server device constantly monitors prescribed folders in the server device;

and when existence of a command file which instructs execution of a designated process is recognized in the prescribed folders, the process instructed by the command file is performed.

2. A method of performing a process according to claim 1, wherein the client device transfers the command file to the server device.

3. A method of performing a process according to claim 1, wherein the client server system configures an OPI system, which creates low resolution image data for editing from high resolution image data, performs an editing operation by using the low resolution image data, and replaces the low resolution image data with the high resolution image data at the time of output, and

the command file commands execution of a designated process which is performed in the OPI system.

5. A method of performing a process according to claim 3, wherein the client device performs the editing operation.

6. A method of performing a process by means of a server device, the method being used in a client server system for executing a designated image processing, in which a client device and a server device are connected via a network, wherein:

the server device constantly monitors prescribed folders in the server device;  
and when existence of a command file which instructs execution of a designated process is recognized in the prescribed folders, the process instructed by the command file is performed.

7. A method of performing a process according to claim 6, wherein the client device transfers the command file to the server device.

8. A method of performing a process according to claim 6, wherein the client server system configures an OPI system, which creates low resolution image data for editing from high resolution image data, performs an editing operation by using the low resolution image data, and replaces the low resolution image data with the high resolution image data at the time of output, and

the command file commands execution of a designated process which is performed in the OPI system.

10. A method of performing a process according to claim 8, wherein the client device performs the editing operation.

11. A client server system for executing a designated data processing, which is configured with a client device and a server device connected via a network, comprising:

a folder monitoring device to monitor prescribed folders in the server device;

a file transfer device to transfer a command file which instructs execution of a designated process to the prescribed folders monitored by the folder monitoring device; and

a process performing device to perform a process instructed by the command file on the server device when existence of the command file is recognized in the prescribed folders.



12. A client server system according to claim 11, further comprising a data replacing device to replace low resolution image data for editing created from high resolution image data with the high resolution image data.

13. A client server system according to claim 11, wherein the client server system configures an OPI system, which creates low resolution image data for editing from high resolution image data, performs an editing operation by using the low resolution image data, and replaces the low resolution image data with the high resolution image data at the time of output, and

the command file instructs execution of a designated process which is performed in the OPI system.

14. A client server system according to claim 13, wherein the client device performs the editing operation.

15. A client server system according to claim 13, wherein the server device replaces the low resolution image data with the high resolution image data at the time of output.

16. A client server system for executing a designated image processing, which is configured with a client device and a server device connected via a network, comprising:

a folder monitoring device to monitor prescribed folders in the server device;

a file transfer device to transfer a command file which instructs execution of a designated process to the prescribed folders monitored by the folder monitoring device; and

a process performing device to perform a process instructed by the command file on the server device when existence of the command file is recognized in the prescribed folders.

17. A client server system according to claim 16, further comprising a data replacing device to replace low resolution image data for editing created from high resolution image data with the high resolution image data.

18. A client server system according to claim 16, wherein the client server system configures an OPI system, which creates low resolution image data for editing from high resolution image data, performs an editing operation by using the low resolution image data, and replaces the low resolution image data with the high resolution image data at the time of output, and the command file instructs execution of a designated process which is performed in the OPI system.

19. A client server system according to claim 18, wherein the client device performs the editing operation.

20. A client server system according to claim 18, wherein the server device replaces the low resolution image data with the high resolution image data at the time of output.

21. A method of performing a process by means of a server device according to claim 1, wherein the client device copies the command file to the server device.

22. A method of performing a process by means of a server device according to claim 1, wherein said command file comprises authentication information comprising a request to manage the prescribed folders.

23. A method of performing a process by means of a server device according to claim 3, wherein said OPI system comprises PostScript comments.

24. A method of performing a process according to claim 3, wherein said low resolution image data comprises:

- a file name of the corresponding high resolution image data;
- a data location path of the high resolution image data;
- a folder ID of the prescribed folder in which the high resolution image is stored; and
- a format information of the high resolution image data.

28. A method of performing a process by means of a server device according to claim 1, wherein an OPI daemon of the server device constantly monitors the prescribed folders of the server device.

33. A method of performing a process by means of a server device according to claim 1, wherein the client device is a processor, and the client provides the command file to the server device.